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James Scott Anderson 1214 Hillwood Court SE Atlanta, GA 30316-2660			SILBERMANN, JOANNE	
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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES SCOTT ANDERSON

Appeal 2008-2139
Application 10/663,498
Technology Center 3600

Decided: May 19, 2008

Before DONALD E. ADAMS, DEMETRA J. MILLS, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

ADAMS, *Administrative Patent Judge*.

REMAND ORDER

STATEMENT OF THE CASE

(1) Appellant and jurisdiction

James Scott Anderson (Appellant) appeals from a Final Rejection set forth in the Final Office Action (Off. Act.) mailed on November 20, 2006. 35 U.S.C. § 134(a) (2002).

We have jurisdiction under 35 U.S.C. § 6(b) (2002).

(2) Filing date and real party in interest

The application on appeal was filed on September 16, 2003.

Appellant is the real party in interest (App. Br. 2).

(3) Claims and arguments on appeal

Claims 1, 2, 4-7, 10-17, and 20-51 are pending in the application (App. Br. 4).

Claims 1, 10-13, 16, and 23-26 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Downing¹ (Off. Act. 2).

Claims 2, 15, 17, and 28 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Downing and Schmeida² (Off. Act. 3).

Claims 4-7 and 20-22 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Downing and Hutchens³ (Off. Act. 4).

¹ U.S. Patent 6,604,789 B1, issued August 12, 2003.

² U.S. Patent 5,727,818, issued March 17, 1998.

³ U.S. Patent 5,581,921, issued December 10, 1996.

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Claims 14 and 27 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Downing and Roche⁴ (*id.*).

Claims 34-38, 40-47, and 49-51 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Weller⁵ and Schmeida (Off. Act. 5).

Claims 39 and 48 were finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Weller, Schmeida and Roche (Off. Act. 6).

The Final Office Action states: “[a] shortened statutory period for reply is set to expire 3 months or thirty (30) days, whichever is longer, from the mailing date of this communication” (Off. Act. 1).

The Final Office Action further states: “[f]ailure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED.” (*Id.*).

A Notice of Appeal was timely filed on February 20, 2007.

According to the Notice of Appeal, “[a]pplicant hereby appeals to the Board of Patent Appeals and Interferences from the last decision of the examiner” (Notice of Appeal). According to the Administrative Record, the last decision of the Examiner was the Final Office Action mailed November 20, 2006.

An Appeal Brief (App. Br.) was timely filed on April 12, 2007.

⁴ U.S. Patent 5,384,999, issued January 31, 1995.

⁵ U.S. Patent 3,526,050, issued September 1, 1970.

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The Appeal Brief makes the following statements regarding the status of the claims:

1. “Claims 1, 2, 4-7, 10-17, and 20-51 are pending in the application” (App. Br. 4).
2. “Claims 29-33 stand withdrawn” (*id.*).
3. “Claims 1, 2, 4-7, 10-17, 20-28, and 34-51 stand finally rejected” (*id.*).
4. “Claims 1, 10-13, 16, 23-26, 34-38, 40-47, and 49-51 are the subject of this appeal” (*id.*).

In the body of the Appeal Brief, Appellant limits the discussion and argument to claims 1, 10-13, 16, 23-26, 34-38, 40-47, and 49-51.

Appellant does not discuss the Examiner's rejection of claims 2, 4-7, 14, 15, 17, 20-22, 27, 28, 39, or 48; nor does Appellant include these claims in the Claims Appendix of the Appeal Brief. Appellant has not, however, submitted an amendment canceling claims 2, 4-7, 14, 15, 17, 20-22, 27, 28, 39, and 48.

In due course, the Examiner entered an Examiner's Answer (Ans.), mailed August 7, 2007.

The Answer, like the Appeal Brief, is limited to a discussion of the rejection of claims 1, 10-13, 16, 23-26, 34-38, 40-47, and 49-51 (*see generally* Ans. 3-6).

A Reply Brief was timely filed on October 9, 2007.

The Reply Brief (Reply Br.) limits its discussion to claims 1, 16, 34, and 43 (*see generally* Reply Br. 1-4).

DISCUSSION

An applicant seeking administrative review of a final rejection must file a notice of appeal. 35 U.S.C. § 134(a); 37 C.F.R. § 41.31(a) (2006).

In the case before us, Appellant filed a Notice of Appeal “to the Board of Patent Appeals and Interferences from the last decision of the examiner.” The Notice of Appeal in this case did not state whether all, or less than all, of the rejected claims were appealed.

In the Appeal Brief, Appellant does not expressly state that claims 2, 4-7, 14, 15, 17, 20-22, 27, 28, 39, and 48 are withdrawn from the appeal. Instead, Appellants expressly stated that only “[c]laims 1, 10-13, 16, 23-26, 34-38, 40-47, and 49-51 are the subject of "this appeal" (App. Br. 4). In addition, Appellants have not submitted an amendment canceling claims 2, 4-7, 14, 15, 17, 20-22, 27, 28, 39, and 48. In an appeal brief, an applicant can withdraw an appeal as to some of the rejected claims. An applicant can withdraw claims by an expressed or implied statement. In the case before us, Appellants did not provide an express statement of withdrawal of claims 2, 4-7, 14, 15, 17, 20-22, 27, 28, 39, and 48, but instead limited the appeal to claims 1, 10-13, 16, 23-26, 34-38, 40-47, and 49-51. Appellant has not appealed claims 2, 4-7, 14, 15, 17, 10-22, 27, 28, 39, and 48 and has not challenged the Examiner’s rejection of these claims. Thus, we treat these claims as withdrawn from the appeal.

If upon filing an appeal brief, the applicant limits the claims to be considered on appeal, then it is the practice of the Patent and Trademark Office to treat the claims not pursued in the appeal brief as having been withdrawn from the appeal. *Manual of Patent Examining Procedure* (MPEP) § 1215.03 (8th ed. Rev. 5, Sept. 2006) states:

A withdrawal of the appeal as to some of the claims on appeal operates as an authorization to cancel those claims from the application . . . and the appeal continues as to the remaining claims. The withdrawn claims will be canceled from the application by direction of the examiner at the time of the withdrawal of the appeal as to those claims. Examiner[s] may use the following form paragraph to cancel the claims that are withdrawn from the appeal at the time of the withdrawal:

. . .

The withdrawal of the appeal as to claims [2, 4-7, 14, 15, 17, 20-22, 27, 28, 39, and 48 in this case] operates as an authorization to cancel these claims from the application. See MPEP § 1215.03. Accordingly, these claims [2, 4-7, 14, 15, 17, 20-22, 27, 28, 39, and 48 in this case] are canceled.

Consistent with the principles set out in MPEP § 1215.03, when an applicant no longer wishes to pursue in the appeal brief rejected claims which were appealed in the notice of appeal, the applicant should file an amendment canceling any claim which the applicant no longer wishes to pursue. *See* 37 C.F.R. § 41.33(b)(1) (2006) and *Ex parte Letts*, http://www.uspto.gov/web/offices/dcom/bpai/prec/rh071392_erratum.pdf, slip op. at 8-9 (Bd. Pat. App. & Int. Jan. 31, 2008) (precedential) ("[i]f an Appellant wants an appeal withdrawn or dismissed as to a particular claim, the proper course of action is to file an amendment canceling the claim.")

DECISION

The application on appeal is remanded to the Examiner so that the Examiner may enter a paper canceling claims 2, 4-7, 14, 15, 17, 20-22, 27, 28, 39, and 48. MPEP § 1215.03.

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Upon entry of the paper, the application should be returned to the Board for consideration of the appeal on its merits as to remaining claims 1, 10-13, 16, 23-26, 34-38, 40-47, and 49-51.

REMANDED

clj

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